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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,635	11/09/2001	Hona Lange	H 3243 PCT/US	4995

23657 7590 07/03/2003

COGNIS CORPORATION
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EXAMINER

TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

9

DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/857,635

Applicant(s)

LANGE ET AL.

Examiner

Philip C Tucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 32 is/are allowed.
- 6) ☒ Claim(s) 11-15, 17, 18, 20-26 and 28-31 is/are rejected.
- 7) ☐ Claim(s) 16, 19 and 27 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 11-15, 17, 18, 20-22, 24-26 and 28-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Bennett et al. (4732213).

Bennett teaches a silica sol based fluid for consolidating soils which comprises a colloidal silica within the scope of the present invention (see claim 1). Bennett teaches that polycarboxylic acids within the scope of the present invention may be used in the silica sol (see examples 67-72).

3. Claims 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Stone (2281810).

Stone teaches an earth consolidation composition which comprises an aqueous silica sol and a phosphonic acid, which is used to consolidate earth (see claims).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (4732213) or Stone (2281810).

Bennett and Stone are taught above. Bennett and Stone differ from the present invention in that sequential addition of the silica sol and polycarboxylic acid or phosphonic acid is not disclosed. The courts have held that process steps taken concurrently are equivalent of steps taken successively (*Asbestos Shingle, Slate & Sheathing Co. vs. Rock Fiber Mfg. Co.* 217 F. 66). It would thus be obvious to one of ordinary skill in the art to use successive steps of adding the silica sol and then acids successively, instead of concurrently as taught in Bennett and Stone.

6. Claims 11-15, 17, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skee (6465403 B1).

Skee teaches a silica sol containing composition which comprises chelating agents, such as polycarboxylic acids (column 7, lines 39-55), having a particle size within the scope of the present invention (see example 19), which is used for cleaning. Skee differs from the present invention in that a specific example of a composition containing the sol and chelating agent at a level of 0.01 to 400 ppm is not disclosed. Skee however teaches that the chelating agent may be present at a level as low as 100 ppm. It would be obvious to one of ordinary skill in the art to make compositions of Skee with polycarboxylic acid chelating agents at a

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level as low as 100 ppm, given the teaching of Skee that such compositions are useful for cleaning.

7. Claims 16, 19 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claim 32 is allowed over the art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Tucker whose telephone number is 703-308-0529. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Philip C Tucker
Primary Examiner
Art Unit 1712

PCT-2836
June 27, 2003